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d/b/a Glidewell Laboratories

8 UNITED STATES DISTRICT COURT
9 CENTRAL DISTRICT OF CALIFORNIA
10 SOUTHERN DIVISION

11 JAMES R. GLIDEWELL DENTAL
12 CERAMICS, INC.,

13 Plaintiff,

14 vs.

15 KEATING DENTAL ARTS, INC.,

16 Defendant.

17 AND RELATED
18 COUNTERCLAIMS.

CASE NO. SACV11-01309-DOC(ANx)

**[PROPOSED] STATEMENT OF
UNCONTROVERTED FACTS AND
CONCLUSIONS OF LAW IN SUPPORT
OF GLIDEWELL'S MOTION FOR
PARTIAL SUMMARY JUDGMENT RE
INFRINGEMENT AND DISMISSAL OF
DEFENDANT'S SECOND
AFFIRMATIVE DEFENSE AND FIRST
COUNTERCLAIM**

Hearing

Date: December 17, 2012
Time: 8:30 a.m.
Ctmm: 9D, Hon. David O. Carter

Pre-Trial Conf.: January 28, 2013
Jury Trial: February 26, 2013

HIGHLY CONFIDENTIAL - FILED UNDER SEAL

(PURSUANT TO PROTECTIVE ORDER DATED JANUARY 30, 2012)

[PROPOSED] STATEMENT OF
UNCONTROVERTED FACTS ISO
GLIDEWELL'S MPSJ RE INFRINGEMENT

Plaintiff and Cross-Counterclaimant James R. Glidewell Dental Ceramics, Inc., (“Glidewell”) having moved for partial summary judgment as against Keating Dental Arts, Inc.’s (“Keating”) on Glidewell’s claim for infringement, Keating’s second affirmative defense, and Keating’s first counterclaim for declaratory relief of non-infringement, the Court finds that the following facts are uncontroverted and makes the conclusions of law set forth below.

I. UNCONTROVERTED FACTS

Uncontroverted Facts	Supporting Evidence
1. James R. Glidewell Dental Ceramics, Inc. (“Glidewell”) is a leading provider of dental restoration products to dentists.	Declaration of Jim Shuck, Exhibit G to the Appendix of Evidence (“Shuck Decl.”) ¶ 4; Declaration of Dr. Ronald Goldstein, Exhibit O to the Appendix of Evidence (“Goldstein Decl.”) ¶ 16.
2. Among the products that Glidewell sells are dental crowns and bridges.	Shuck Decl. ¶ 4.
3. A crown is a type of dental restoration product that completely caps a tooth.	Shuck Decl. ¶ 4.
4. A crown is typically bonded to the tooth using dental cement or resin.	Shuck Decl. ¶ 4; Declaration of Stuart R. Newman, Exhibit B to the Appendix of Evidence (“Newman Decl.”) ¶ 3; Declaration of Terence J. Michiels, Exhibit Q to the Appendix of Evidence (“Michiels Decl.”) ¶ 3; Declaration of Spencer D. Luke, Exhibit D to the Appendix of Evidence (“Luke Decl.”) ¶ 3; Declaration of Gregory Doneff,

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1		Exhibit A to the Appendix of Evidence
2		("Doneff Decl.") ¶ 3; Declaration of
3		Thomas E. Bell, Exhibit E to the
4		Appendix of Evidence ("Bell Decl.") ¶
5		3; Declaration of Howard S. Cohen,
6		Exhibit C to the Appendix of Evidence
7		("Cohen Decl.") ¶ 3; Declaration of
8		Kent J. Toca, Exhibit F to the
9		Appendix of Evidence ("Toca Decl.")
10		¶ 3.
11	5. In the past, crowns were principally	Shuck Decl. ¶ 5.
12	fashioned either from gold (which has	
13	favorable tensile characteristics but is	
14	considered aesthetically unappealing by	
15	many people) or from porcelain	
16	veneers fused to a metal casting (which	
17	is aesthetically appealing but tends to	
18	crack when subjected to heavy pressure	
19	or grinding).	
20	6. More recently, dental laboratories	Shuck Decl. ¶ 5.
21	began to fashion crowns made of a	
22	veneer fused or adhered to a hard	
23	ceramic such as zirconia.	
24	7. However, these crowns too tended	Shuck Decl. ¶ 5.
25	to crack when subjected to heavy	
26	grinding.	
27	8. Beginning in 2005, Glidewell began	Declaration of Robin Carden, Exhibit J
28		

1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22	developing a new type of crown, a solid zirconia crown.	to the Appendix of Evidence, ¶ 2.
23 24 25 26 27 28	9. The advantages of this new monolithic zirconia (or “full contour zirconia”) crown were that it would be extremely hard – sufficiently hard to be used in applications requiring a material with high tensile and compressive strength, including treating patients with “bruxism,” a parafunctional activity in which a person repeatedly and habitually grinds his teeth – and that it could be milled from a block of zirconia based on a digital representation of the patient’s mouth. Glidewell’s crowns are not used only by people who suffer from bruxism; they are used by a variety of patients who choose to have monolithic zirconia crowns due to tooth damage caused by a variety of conditions.	Shuck Decl. ¶ 9, Declaration of Michael C. DiTolla, Exhibit I to the Appendix of Evidence (“DiTolla Decl.”) ¶ 18; Newman Decl. ¶ 11; Michiels Decl. ¶ 11; Luke Decl. ¶ 11; Doneff Decl. ¶ 11; Bell Decl. ¶ 11; Cohen Decl. ¶ 11; Toca Decl. ¶ 11.
	10. The disadvantage was that zirconia is an unattractive material, due to its extreme whiteness and lack of translucency.	Shuck Decl. ¶ 10, DiTolla Decl. ¶ 18.
	11. Ultimately, Glidewell partially overcame the aesthetic challenges of	Shuck Decl. ¶ 10, DiTolla Decl. ¶ 18.

the material, devising a process for fabricating a full contour zirconia crown that was sufficiently appealing that it could be used in a variety of applications.

12. In early 2009, Glidewell conceived the name for its new line of monolithic zirconia dental restoration products: BruxZir.

13. The name was chosen in large part because it suggested the primary characteristics of the product: that it was sufficiently strong and durable to be used in a variety of applications, including treating patients with bruxism ("Brux"), and that the material from which the crown was fashioned is zirconia ("Zir").

14. Glidewell's line of monolithic zirconia dental restoration products, including full contour zirconia crowns, was launched under the BruxZir mark in June 2009.

15. Glidewell has been marketing monolithic zirconia dental restoration products, including full contour zirconia crowns, under the BruxZir

Shuck Decl. ¶¶ 8, 9.

Shuck Decl. ¶ 9; Goldstein Decl. ¶ 17; Declaration of David Franklyn, Exhibit N to the Appendix of Evidence ("Franklyn Decl.") ¶ 42; Declaration of Rudy Ramirez, Exhibit H to the Appendix of Evidence ("Ramirez Decl.") ¶ 4.);.

Shuck Decl. ¶ 7.

Shuck Decl. ¶¶ 38, 39.

1	mark continuously since June 2009.	
2	16. Since its introduction in 2009, the	Shuck Decl. ¶ 41.
3	BruxZir line of restoration products	
4	(primarily dental crowns and bridges)	
5	has been phenomenally popular,	
6	generating nearly \$ REDACTED in	
7	revenue from July 2009 through	
8	September 2012.	
9	17. Glidewell has promoted the	Shuck Decl. ¶¶ 38, 39; Goldstein Decl.
10	BruxZir product line heavily, investing	¶ 16.
11	nearly \$ REDACTED in advertising its	
12	products under the mark from June	
13	2009 to June 2012.	
14	18. Glidewell applied to register the	Declaration of Keith Allred, Exhibit L
15	BruxZir mark on June 7, 2009 for use	to the Appendix of Evidence ("Allred
16	in connection with dental bridges,	Decl.") ¶ 5, Exs. 59-60.
17	dental caps, dental crowns, dental	
18	inlays, dental onlays, and dental	
19	prostheses.	
20	19. Glidewell's BruxZir mark was	Allred Decl. ¶ 5, Exs. 59-60.
21	registered on the Principal Register for	
22	use in connection with dental bridges,	
23	dental caps, dental crowns, dental	
24	inlays, dental onlays, and dental	
25	prostheses on January 19, 2010, as Reg.	
26	No. 3,739,663.	
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20. Glidewell owns U.S. Trademark Reg. No. 3,739,663.	Allred Decl. ¶ 5, Exs. 59-60.
21. In May 2011, Keating Dental Arts, Inc. ("Keating") began to offer full contour zirconia dental crowns and bridges under the brand "KDZ Bruxer."	Shuck Decl. ¶ 15.
22. The BruxZir mark suggests, but does not directly describe, a particular quality or characteristic of the dental restoration products that Glidewell offers under the mark.	Franklyn Decl. ¶ 42.
23. The BruxZir mark suggests that crowns marketed under the brand are strong because they are appropriate for patients who "brux," i.e., who grind their teeth, and also suggests that the crowns are made from zirconia, a particularly hard material.	Shuck Decl. ¶ 9; Goldstein Decl. ¶ 26.
24. Glidewell's crowns are not used only by people who suffer from bruxism; they are used by a variety of patients who choose to have monolithic zirconia crowns due to tooth damage caused by a variety of conditions.	Shuck Decl. ¶ 9, DiTolla Decl. ¶ 14.
25. Glidewell markets crowns and bridges under the BruxZir mark to dentists in the United States.	Shuck Decl. ¶¶ 20-26; Newman Decl. ¶ 3; Michiels Decl. ¶ 3; Luke Decl. ¶ 3; Doneff Decl. ¶ 3; Bell Decl. ¶ 3; Cohen

	Decl. ¶ 3; Toca Decl. ¶ 3.
26. Glidewell promotes its dental crowns and bridges under the BruxZir mark through the Internet (through Glidewell's blog as well as www.BruxZir.com), direct mailers, trade shows, ads in dental industry publications, press releases, continuing education brochures, videos and training sessions for dentists, samples, and specialized prescription forms.	Shuck Decl. ¶¶ 20-26; Newman Decl. ¶ 3; Michiels Decl. ¶ 3; Luke Decl. ¶ 3; Doneff Decl. ¶ 3; Bell Decl. ¶ 3; Cohen Decl. ¶ 3; Toca Decl. ¶ 3; Goldstein Decl. ¶ 19, DiTolla Decl. ¶¶ 4, 6-7, 10.
27. Over the period June 2009 to June 2012, Glidewell spent approximately \$ REDACTE D in promoting its BruxZir finished crowns and bridges through these channels.	Shuck Decl. ¶¶ 38, 39; Goldstein Decl. ¶ 16.
28. Over the period June 2009 to June 2012, Glidewell spent approximately \$ REDACTE D marketing Glidewell's BruxZir finished crowns and bridges, and about \$ REDACTE D was spent marketing Glidewell's BruxZir zirconia milling blanks.	Shuck Decl. ¶ 39.
29. Over the period June 2009 to June 2012, Glidewell spent approximately \$ REDACTED on direct mail advertising for BruxZir finished crowns and	Shuck Decl. ¶ 38.

bridges, which was sent to roughly every dentist in the country, and another roughly \$^{REDACT} ED on advertising in dental industry publications, with the remainder being allocated among Glidewell's other marketing channels.

30. Glidewell's advertising of crowns and bridges under the BruxZir mark has accomplished substantial market penetration.

31. For example, between October 2009 and November 2012, the www.BruXZir.com website received approximately 289,210 unique pageviews, of which 78% constituted U.S. traffic.

32. There are approximately 125,000 dentists in the United States.

33. Glidewell's direct mail advertising of crowns and bridges under the BruxZir mark is sent every quarter to nearly the entire population of dentists in the country.

34. Glidewell's promotion of the BruxZir line of crowns and bridges in

Shuck Decl. ¶¶ 11-12, 21; Goldstein Decl. ¶¶ 16, 19; Newman Decl. ¶ 3-6; Michiels Decl. ¶ 3-6; Luke Decl. ¶ 3-6; Doneff Decl. ¶ 3-6; Bell Decl. ¶ 3-6; Cohen Decl. ¶ 3-6; Toca Decl. ¶ 3-6;.

Shuck Decl. ¶ 21; Goldstein Decl. ¶ 16.

Shuck Decl. ¶ 21; Goldstein Decl. ¶ 16.

Shuck Decl. ¶ 24.

Shuck Decl. ¶ 22; Goldstein Decl. ¶ 19; Newman Decl. ¶ 3; Michiels Decl. ¶ 3;

1 dental industry publications is	Luke Decl. ¶ 3; Doneff Decl. ¶ 3; Bell
2 consistent, ongoing and pervasive.	Decl. ¶ 3; Cohen Decl. ¶ 3; Toca Decl.
3	¶ 3;
4 35. Advertisements promoting	Shuck Decl. ¶ 22; Newman Decl. ¶ 3;
5 Glidewell's BruxZir crowns and	Michiels Decl. ¶ 3; Luke Decl. ¶ 3;
6 bridges run in numerous publications,	Doneff Decl. ¶ 3; Bell Decl. ¶ 3;
7 including ADA News (once a month),	Cohen Decl. ¶ 3; Toca Decl. ¶ 3;
8 Chairside Magazine, Dental	Goldstein Decl. ¶ 19; DiTolla Decl.,
9 Economics, Dental Lab Reports,	¶¶ 6-7.
10 Dentaltown, Dental Tribune, Dentistry	
11 Today, Inclusive Magazine, JDT, and	
12 LMT.	
13 36. Glidewell selects ADA News,	Shuck Decl. ¶ 22.
14 Chairside Magazine, Dental	
15 Economics, Dental Lab Reports,	
16 Dentaltown, Dental Tribune, Dentistry	
17 Today, Inclusive Magazine, JDT, and	
18 LMT because of their wide readership	
19 and ability to reach thousands, if not	
20 hundreds of thousands, of dentists and	
21 dental laboratories.	
22 37. Glidewell attends dozens of trade	Shuck Decl. ¶ 26; Michiels Decl. ¶ 3;
23 shows and conventions a year around	Luke Decl. ¶ 3; Doneff Decl. ¶ 3.
24 the country, especially the American	
25 Dental Association conventions.	
26 38. At these conventions and trade	Shuck Decl. ¶ 26; Michiels Decl. ¶ 3;
27 shows, Glidewell consistently,	Luke Decl. ¶ 3; Doneff Decl. ¶ 3.
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<p>prominently displays the BruxZir mark in connection with its line of dental crowns and bridges in a variety of contexts, including on the booth, the signage, in brochures, and takeaways.</p>	
<p>39. Dr. Michael DiTolla, Glidewell's Director of Clinical Education and Research, and Robin Carden, Glidewell's Vice President of Research and Development, make educational videos, write articles and give presentations concerning Glidewell's BruxZir-branded products.</p>	<p>Shuck Decl. ¶¶ 27-29; Luke Decl. ¶ 3; DiTolla Decl. ¶¶ 4, 6-7, 10.</p>
<p>40. Dr. DiTolla's presentations and videos are viewed by thousands of dentists every year.</p>	<p>Shuck Decl. ¶ 27.</p>
<p>41. Glidewell's BruxZir branded line of dental restoration products has received wide recognition and acclaim in the dental industry.</p>	<p>Shuck Decl. ¶¶ 30-36; Goldstein Decl. at ¶ 20; Newman Decl. ¶ 3-6; Michiels Decl. ¶ 3-6; Luke Decl. ¶ 3-6; Doneff Decl. ¶ 3-6; Bell Decl. ¶ 3-6; Cohen Decl. ¶ 3-6; Toca Decl. ¶ 3-6;.</p>
<p>42. Numerous articles have been written by third parties concerning the BruxZir dental restoration products and referencing them by Glidewell's registered mark.</p>	<p>Shuck Decl. ¶ 30.</p>
<p>43. Glidewell has received numerous</p>	<p>Shuck Decl. ¶¶ 32-36; Goldstein Decl.</p>

1 2 3 4 5 6 7 8 9 10 11 12 13	awards recognizing the superiority of its BruxZir-brand dental crowns and bridges, including (1) the 2010 Best Product Innovation Award from Tosch Corporation, (2) the Journal of Dental Technology's Wow! 2011 Products Awards, (3) Inside Dental Technology 2011 iNavigator Top Pick, (4) 2011 Best Product from Clinician's Report, (4) the Pride Institute's 2012 Best of Class Technology Award, and (5) 2012 semifinal candidate for Best New Material.	¶ 20.
14 15 16	44. BruxZir is the number one prescribed brand of full zirconia dental crown in the country.	Shuck Decl. ¶ 12.
17 18 19 20	45. From June 2009 to September 2012, Glidewell has sold approximately REDACTED dental crowns and bridges under the mark.	Shuck Decl. ¶ 41.
21 22 23 24 25	46. In monetary terms, from July 2009 to September 2012 Glidewell sold nearly \$ REDACTED worth of dental crowns and bridges under the BruxZir mark.	Shuck Decl. ¶ 41.
26 27 28	47. The BruxZir mark has achieved wide recognition among dentists in the	Shuck Decl. ¶¶ 11, 30-36; Newman Decl. ¶¶ 4-6, 9-10; Michiels Decl. ¶¶ 4-

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1 2 3 4	U.S. for dental crowns and bridges.	6, 9-10; Luke Decl. ¶¶ 4-6, 9-10; Doneff Decl. ¶¶ 4-6, 9-10; Bell Decl. ¶¶ 4-6, 9-10; Cohen Decl. ¶¶ 4-6, 8-10; Toca Decl. ¶¶ 4-6, 9-10.
5 6 7 8 9 10 11 12	48. In 2010, Dentsply, the second largest dental company in the United States and a manufacturer of ceramic products, conducted research to identify brands for fixed products (such as crowns and bridges) that have a high degree of recognition among dentists and dental laboratories in the U.S.	Shuck Decl. ¶ 11.
13 14 15 16 17	49. The results of Dentsply's research indicated that Glidewell's BruxZir mark had a high degree of recognition among dentists and dental laboratories in the U.S.	Shuck Decl. ¶ 11.
18 19 20 21 22 23 24 25 26 27 28	50. There are only five marks used in commerce in the U.S. that sound anything like BruxZir for use in connection with either dental crowns or with constitutive materials: (1) Glidewell's registered BruxZir mark; (2) Glidewell's unregistered BruxZir mark; (3) Keating's KDZ Bruxer mark; (4) "GPS BruxArt" (a competitor's junior pending mark); and (5)	Franklyn Decl. ¶ 46.

1	"BruxThetix" (another competitor's	
2	junior pending mark).	
3	51. The BruxZir mark is relatively	Franklyn Decl. ¶ 46.
4	unique in its field in the U.S.	
5	52. The BruxZir mark is commercially	Franklyn Decl. ¶ 46; Newman Decl.
6	strong with respect to dental crowns	¶¶ 3-6, 9-10; Michiels Decl. ¶¶ 3-6, 9-
7	and bridges in the U.S.	10; Luke Decl. ¶¶ 3-6, 9-10; Doneff
8		Decl. ¶¶ 3-6, 9-10; Bell Decl. ¶¶ 3-6, 9-
9		10; Cohen Decl. ¶¶ 3-6, 8-10; Toca
10		Decl. ¶¶ 3-6, 9-10; Goldstein Decl.
11		¶¶ 15-16, 21.
12	53. Keating's dental crowns and	Shuck Decl. ¶ 15; Luke Decl. ¶ 12;
13	bridges marketed under the KDZ	Bell Decl. ¶ 12; Goldstein Decl. ¶ 25.
14	Bruxer brand compete directly with	
15	Glidewell's dental crowns and bridges	
16	marketed under the BruxZir mark.	
17	54. Both Glidewell and Keating sell	Declaration of William Wong, Exhibit
18	full contour zirconia crowns and	P to the Appendix of Evidence ("Wong
19	bridges under their respective BruxZir	Decl.") ¶ 8, Ex. 81 (no. 6); Wong Decl.
20	and KDZ Bruxer marks.	¶ 14, Ex. 87 (no. 2); Newman Decl. ¶¶
21		4-6, 9-10; Michiels Decl. ¶¶ 4-6, 9-10;
22		Luke Decl. ¶¶ 4-6, 9-10, 12; Doneff
23		Decl. ¶¶ 4-6, 9-10; Bell Decl. ¶¶ 4-6,
24		9-10, 12; Cohen Decl. ¶¶ 4-6, 8-10;
25		Toca Decl. ¶¶ 4-6, 9-10.
26	55. Both Glidewell and Keating sell	Wong Decl., ¶ 12, Exhibit 85 (104:24-
27	dental crowns and bridges under their	105:3); Luke Decl. ¶ 12; Bell Decl. ¶
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1	respective BruxZir and KDZ Bruxer	12.
2	marks throughout the United States.	
3	56. Both Glidewell and Keating sell	Shuck Decl. ¶ 15.
4	full contour zirconia crowns and	
5	bridges under their respective BruxZir	
6	and KDZ Bruxer marks.	
7	57. Both Keating and Glidewell sell	Shuck Decl. ¶ 15.
8	full contour zirconia crowns and	
9	bridges to the same universe of	
10	potential buyers – dentists throughout	
11	the U.S.	
12	58. Glidewell’s BruxZir crowns are	Shuck Decl. ¶ 16.
13	sold at a comparable price point to	
14	Glidewell’s KDA Bruxer crowns.	
15	59. Glidewell’s BruxZir crowns are	Shuck Decl. ¶ 16.
16	sold for \$99 per crown, excluding	
17	rebates, promotions and other special	
18	pricing.	
19	60. Keating’s KDA Bruxer crowns are	Wong Decl. ¶ 13, Ex. 86 (43:17-20);
20	sold for \$139 per crown, excluding	DiTolla Decl. ¶ 15, Ex. 76.
21	rebates, promotions and other special	
22	pricing.	
23	61. Dentists in the U.S. consider	Bell Decl. ¶ 12; Luke Decl. ¶ 12.
24	Glidewell’s BruxZir crowns and	
25	Keating’s KDZ Bruxer crowns to be	
26	directly competitive.	
27	62. Of the 22 dentists that Keating	Declaration of Rudy Ramirez , Exhibit
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1 identified as Keating customers who	H to the Appendix of Evidence
2 had purchased a KDZ Bruxer crown in	("Ramirez Decl.") ¶ 6.); Wong Decl. ¶
3 Keating's Third Amended Disclosures,	16, Ex. 88.
4 nine – i.e., 41% – had previously	
5 purchased one or more BruxZir crowns	
6 from Glidewell.	
7 63. Glidewell's BruxZir mark does not	Shuck Decl. ¶ 19. Ex. 8.
8 include two or more separable word	
9 elements or a design or logo.	
10 64. Keating capitalizes the first letter	DiTolla Decl. ¶ 15, Ex. 76.
11 of the "Bruxer" component of its mark,	
12 just as Glidewell capitalizes the first	
13 letter of "BruxZir."	
14 65. Keating's KDZ Bruxer mark	Shuck Decl. ¶ 19. Ex. 8; DiTolla Decl.
15 prefaces a root word ("Bruxer") that is	¶¶ 15, 19, Exs. 3-4, 76.
16 nearly identical to the entirety of	
17 Glidewell's mark ("BruxZir") with a	
18 three-letter acronym ("KDZ") that does	
19 not on its face serve any source-	
20 identifying function.	
21 66. In the text of Keating's	DiTolla Decl. ¶ 15, Ex. 76.
22 advertisements the term KDZ is no	
23 more prominent than the "Bruxer"	
24 component of its mark.	
25 67. Dentists are not likely to consider	Shuck Decl. ¶ 18; DiTolla ¶ 20.
26 the BruxZir and KDZ Bruxer marks	
27 side by side as a shopper would two	
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1	competing brands in a supermarket;	
2	instead, they are likely to consider the	
3	marks separately at different points in	
4	time.	
5	68. Subtle differences in the BruxZir	Goldstein Decl. ¶ 26.
6	and KDZ Bruxer marks are less likely	
7	to be “in the buyer’s mind” when the	
8	buyer makes the decision to purchase	
9	Keating’s dental crowns under the	
10	KDZ Bruxer mark than if products	
11	marketed under the two marks were	
12	offered side by side.	
13	69. The BruxZir mark and the KDZ	Wong Decl. ¶ 12, Ex. 85 (43:15-44:8,
14	Bruxer mark suggest similar meanings.	83:9-15); Shuck Decl. ¶ 9; Goldstein
15		Decl. ¶ 26; DiTolla ¶ 14; Franklyn
16		Decl. ¶ 49).
17	70. BruxZir suggests a product	Shuck Decl. ¶ 9; Goldstein Decl. ¶ 26;
18	indicated for people who suffer from	DiTolla ¶ 14; Wong Decl. ¶ 12, Ex. 85
19	bruxism, i.e., people who tend to grind	(43:15-44:8, 83:9-15).
20	their teeth (“Brux”) and that the	
21	product is made of zirconia (“Zir”).	
22	71. REDACTED	Franklyn Decl. ¶ 49; Wong Decl. ¶ 12,
23	REDACTED	Ex. 85 (43:15-44:8, 83:9-15).
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26	REDACTED	
27	72. REDACTED	Declaration of Nicole Fallon, Exhibit
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<p>REDACTED</p>	<p>M to the Appendix of Evidence, ¶¶ 4-10, Ex. 2; Goldstein Decl. ¶ 23.</p>
<p>73.</p> <p>REDACTED</p>	<p>Wong Decl. ¶ 11, Ex. 84 (56:23-57:6); Wong Decl. ¶ 4, Ex. 15.</p>

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74.	REDACTED REDACTED	Wong Decl. ¶ 11, Ex. 84 (58:11-14, 68:12-18); Wong Decl. ¶ 4, Ex. 15.
75.	REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3355, 3358); Goldstein Decl. ¶ 28.
76.	REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3350, 3352).

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77. REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3359, 3362).
78. REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3363, 3366).
79. REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3367, 3370).
80. REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3371-3373).

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1	REDACTED	
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3	81. REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3375-
4	REDACTED	3377).
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10	82. REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3384,
11	REDACTED	3386).
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17	83. REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3392,
18	REDACTED	3394).
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24	84. REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3404,
25	REDACTED	3406).
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85.	REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA3444, 3446).
86.	REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15 (KDA 3486-3488).
87.	REDACTED REDACTED	Wong Decl. ¶ 4, Ex. 15.
88.	REDACTED REDACTED	Newman Decl. ¶ 3; Michiels Decl. ¶ 3; Luke Decl. ¶ 3; Doneff Decl. ¶ 3; Bell

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Decl. ¶ 3; Cohen Decl. ¶ 3; Toca Decl. at 3; Goldstein Decl. ¶¶ 27-28; Wong Decl. ¶ 12, Ex. 85 (105:4-25).

89.

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Wong Decl. ¶ 8, Ex 81 (no. 21); Wong Decl. ¶ 11, Ex. 84 (26:11-20 & 70:23-71:17; Exh. 514; 90:15-25; Exh. 519; 93:19-94:5 and Exh. 520); Wong Decl. ¶ 12, Ex. 85 (92:14-93:12; 104:24-106:10).

90. Glidewell and Keating promote their respective BruxZir and KDZ Bruxer products in some of the same magazines – such as ADA News, Dental Economics, Dentistry Today, and Dentaltown.

Wong Decl. ¶ 9, Ex. 82 (no. 10); Newman Decl. ¶ 3; Michiels Decl. ¶ 3; Luke Decl. ¶ 3; Doneff Decl. ¶ 3; Bell Decl. ¶ 3; Cohen Decl. ¶ 3; Toca Decl. ¶ 3.

91. Glidewell's BruxZir brand crowns, Keating's KDZ Bruxer crowns, and other competitors' full contour zirconia crowns have similar features and are generally indicated for the same uses. Many dentists may regard them as interchangeable.

DiTolla Decl. ¶ 21.

92. While there are aesthetic

Franklyn Decl. ¶ 49.

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1	differences between different brands of	
2	full contour zirconia crown, the	
3	properties of these crowns are highly	
4	similar because all of these crowns are	
5	made of the same material – zirconia.	
6	93. REDACTED	
7	REDACTED	Wong Decl. ¶ 11, Ex. 84 (92:15-93:3).
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9	94. By the spring of 2011, Glidewell's	Newman Decl. ¶¶ 3-6, 9-10; Michiels
10	BruxZir mark was already well known	Decl. ¶¶ 3-6, 9-10; Doneff Decl. ¶¶ 3-
11	in the industry.	6, 9-10; Bell Decl. ¶¶ 3-6, 9-10; Cohen
12		Decl. ¶¶ 3-6, 8-10; Toca Decl. ¶¶ 3-6,
13		9-10.
14	95. By the spring of 2011, Glidewell REDACTED	Shuck Decl. ¶ 15.
15	had already spent about \$	
16	promoting its goods under the BruxZir	
17	mark.	
18	96. REDACTED	
19	REDACTED	Wong Decl. ¶ 11, Ex. 84 (92:15-93:7);
20		Wong Decl. ¶ 8, Ex. 81.
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27	97. REDACTED	
28		Wong Decl. ¶ 11, Ex. 84 (93:4-11).

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5 **II. CONCLUSIONS OF LAW**

6 1. Glidewell owns the trademark registration for BruxZir on the class of
7 goods including dental crowns and bridges.

8 2. Glidewell is the senior user, as it has been marketing its goods under
9 the BruxZir mark since June 2009, whereas Keating commenced marketing its
10 competing goods under its KDZ Bruxer mark in May 2011.

11 3. Glidewell's BruxZir mark is suggestive, and therefore inherently
12 distinctive. This factor weighs in favor of finding a likelihood of confusion.
13 *Conversive, Inc. v. Conversagent, Inc.*, 433 F. Supp. 2d 1079, 1090 (C.D. Cal.
14 2006) (granting summary judgment in favor of registered mark).

15 4. Glidewell's BruxZir mark is commercially strong. This factor
16 weighs in favor of finding a likelihood of confusion. *Century 21 Real Estate Corp.*
17 *v. Sandlin*, 846 F.2d 1175 (9th Cir. 1988).

18 5. Glidewell's BruxZir crowns and bridges and Keating's KDZ Bruxer
19 crowns and bridges directly compete. This factor favors the conclusion that
20 confusion is highly likely. *Century 21*, 846 F.2d at 1179 (the fact that the goods
21 marketed under the marks were "essentially the same" supported summary
22 judgment in favor of the registered mark); *Conversive*, 433 F.Supp.2d at
23 1091(finding that the fact that the "type of goods and services at issue" were the
24 same supported summary judgment in favor of the registered mark).

25 6. Glidewell's BruxZir mark and Keating's KDZ Bruxer mark are highly
26 similar in appearance and meaning. This factor supports a finding that confusion is
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likely. *Apple Computer, Inc. v. Formula International, Inc.*, 725 F.2d 521 (9th Cir. 1984); *Conversive*, 433 F.Supp.2d at 1091.

7. There is pervasive evidence of actual confusion in this case, which includes evidence of at least 87 separate incidents of actual confusion. This factor strongly favors a finding that confusion is likely. *Conversive, Inc.*, 433 F. Supp. 2d at 1093.

8. The channels through which Glidewell's BruxZir-brand dental crowns and bridges are marketed are nearly identical to those through which Keating's KDZ Bruxer-brand dental crowns and bridges are marketed, and include the Internet, direct mailers and trade journals. This factor favors a finding that confusion is likely. *Century 21*, 846 F.2d at 1179 (the fact that the marketing channels were "substantially the same" supported summary judgment in favor of the registered mark); *PerfumeBay.com Inc. v. eBay Inc.*, 506 F.3d 1165, 1174-75 (9th Cir.2007) (courts consider the use of the Internet as a marketing and advertising channel "as exacerbating the likelihood of confusion.").

9. The type of goods at issue in this case are not such as to require a high degree of care. However, even if a high degree of care was used by dentists in selecting a particular brand of full contour zirconia crown, the fact that dentists (who are presumably sophisticated consumers) are actually confused shows that the likelihood of confusion based on the degree of care factor is enhanced. *Conversive*, 433 F.Supp.2d at 1093. Moreover, even where a high degree of care is exercised, initial interest confusion may still exist. *Id.* Thus, this factor favors a finding that confusion is likely.

10. The evidence indicates that Keating was aware of Glidewell's BruxZir mark when it made the decision to begin selling competing products under the KDZ Bruxer mark. This factor, then, favors a finding of likelihood of confusion. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1293 (9th Cir.1992) (citing *Sleekcraft*, 599 F.2d at 354).

11. The fact that Glidewell's BruxZir-brand full contour zirconia crowns and bridges already compete with Keating's KDZ Bruxer full contour zirconia crowns indicates that the "likelihood of expansion" factor favors a finding that confusion is likely. *Conversive*, 433 F.Supp.2d at 1093.

12. There is no genuine issue of material fact but that confusion among the relevant market of consumers (dentists) regarding source, affiliation, association or endorsement over Glidewell's registered BruxZir mark is likely to result if Keating continues to market full contour zirconia crowns and bridges under the KDZ Bruxer mark.

13. Partial summary judgment is entered in favor of Glidewell and against Keating on Glidewell's First Cause of Action for Infringement of a Federally Registered Mark.

14. Partial summary judgment is entered in favor of Glidewell and against Keating on Keating's Second Affirmative Defense of No Likelihood of Confusion.

15. Partial summary judgment is entered in favor of Glidewell and against Keating on Keating's First Counterclaim for Declaratory Judgment of Non-Infringement.

Dated:

By:

Hon. David O. Carter
United States District Judge

Glidewell Laboratories v. Keating Dental Arts, Inc.
United States District Court, Central, Case No. SACV11-01309-DOC (ANx)

CERTIFICATE OF SERVICE

I hereby certify that on November 19, 2012, I electronically filed the document described as **[PROPOSED] STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF GLIDEWELL'S MOTION FOR PARTIAL SUMMARY JUDGMENT RE INFRINGEMENT AND DISMISSAL OF DEFENDANT'S SECOND AFFIRMATIVE DEFENSE AND FIRST COUNTERCLAIM** with the Clerk of the Court using the CM/ECF System which will send notification of such filing to the following:

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